

## **REMARKS**

In response to the Advisory Action mailed on January 6, 2005, the Applicant is filing a request for continued examination (RCE) pursuant to 37 C.F.R. § 1.114, along with this Preliminary Amendment. In the Advisory Action, the Examiner maintained the rejection of claims 1-52 as presented in the Final Office Action mailed on September 9, 2004. Claims 1, 13, 22, 23, 25, 31, 38, and 46 are presently amended to clarify certain features and expedite allowance of the present application. Additionally, new claims 53-64 are being presented for examination. These amendments do not add any new matter.

In the Final Office Action mailed on September 9, 2004, claims 1-4, 7-10, 13-17, 20-25, 28-33, 36-40, 43-48, 51 and 52 were rejected under 35 U.S.C. § 103(a) as being obvious over Monier (U.S. Patent No. 5,974,455) in view of Najork (U.S. Patent No. 6,301,614 "Najork '614"). Additionally, claim 22 was rejected under 35 U.S.C. § 103(a) as being obvious over Monier in view of Najork (U.S. Patent No. 6,321,265 "Najork '265") in further view of Najork '614. Claims 5, 6, 11, 12, 18, 19, 26, 27, 31, 32, 34, 35, 49, and 50 were rejected under 35 U.S.C. § 103(a) as being obvious over Monier in view of Najork '614 in further view of Cabrera et al. (U.S. Patent No. 5,953,729). In view of the current amendments and remarks, the Applicant respectfully requests reconsideration and allowance of the pending claims.

### **The Advisory Action**

In the Advisory Action, the Examiner maintained the rejections of the Final Office Action. Specifically, the Examiner stated:

Claims 1-52 remain rejected under 103(a) since the arguments addressed in the response filed 11/15/2004 are not persuasive.

...

Applicant is arguing that the examiner must provide reasoning to support the determination of inherency of Monier regarding the limitation “without determining whether the representation is stored in the disk file.” The previous office action states that Monier discloses determining whether the representation is stored in the hash table (buffer), and when this determination is negative, storing the representation in the hash table (buffer) (column 5 line 43 – column 6 line 22). The inherency of the limitation “without determining whether the representation is stored in the first disk file” is because when Monier determines whether the representation is stored in the hash table (buffer), Monier does not also determine whether the representation is stored in the first disk file.

Applicant is arguing that Najork ‘614 does not teach an ordered merge that comprises preventing duplication of any of the representations of data set addresses. However, Najork ‘614 does disclose a merging process as mentioned in the prior office action (column 3 line 30 – column 4 line 45 and column 6 line 1 – column 7 line 25)(see also figure 4). Najork ‘614 also discloses wherein the merging process involves preventing duplication (column 3 line 30 – column 4 line 45 and column 6 line 1 – column 7 line 25)(see also figure 4). As stated in the previous office action, it is irrelevant when the duplicate prevention takes place since the claim language doesn’t explicitly specify when. The usage of the term ‘comprise’ does not delimit a time period.

Applicant argues that it is thus not necessary to modify the claim language to say preventing duplication after merging. However, this limitation is not found in the claims which leaves the claim language broad, and renders the claim broadly interpreted. Claimed subject matter, not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1986); In re Self, 213 USPQ 1, 5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978).

Advisory Action, pp. 2, 3.

The Applicant respectfully traverses the rejections. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (P.T.O. Bd. App. 1979). Obviousness cannot be established by combining the teachings

of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

As discussed in the Response to Final Office Action Dated September 9, 2004, based on the legal precedent set forth above, the Applicant does not concede the correctness of the Examiner's rejections. However, in view of the Examiner's comments, the Applicant presently amends claims 1, 13, 22, 23, 25, 31, 38, and 46 in the interest of furthering prosecution. Specifically, the Applicant presently amends independent claim 1 to recite "preventing duplication of any of the representations of data set addresses stored in the first disk file *after the ordered merge*." (Emphasis added). The Applicant presently amends independent claim 13 to recite "preventing duplication of any of the representations of data set addresses stored in the first disk file *during or after merging*." (Emphasis added). Additionally, the Applicant presently amends independent claims 22, 23, 31, 38, and 46 to

recite preventing duplication of any representations of data set addresses stored in a first disk file “*during or after* merging the contents of the buffer into the contents of the first disk file.” (Emphasis added).

In view of the amendments set forth above, the Applicant asserts that the referenced prior art, separately and in combination, clearly fails to teach or suggest each and every aspect of the amended independent claims. Accordingly, the Applicant requests that the Examiner withdraw the rejections under 35 U.S.C. § 103 and provide an indication of allowance.

### **New Claims**

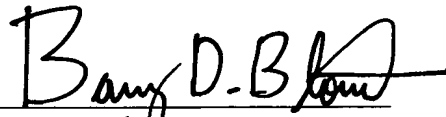
As discussed above, the Applicant presently adds new claims 53-64. Independent claim 53 recites “preventing duplication of any of the representations of data set addresses stored in the first disk file *during* the ordered merge.” (Emphasis added). The cited references, separately and in combination, fail to teach or suggest this aspect of the present invention. Accordingly, the Applicant requests that the Examiner provide an indication of allowance for new independent claim 53. Additionally, the Applicant requests that the Examiner provide an indication of allowance for the claims depending from claim 53 based on their dependency and based on unique matter recited in each dependent claim.

## **Conclusion**

The Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Date: February 9, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barry D. Blount", written over a horizontal line.

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